

Atty. Docket No. Q66004
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/964,337

REMARKS

Claims 1 – 9 were previously pending. Claim 7 was previously cancelled. Claims 10 – 24 are herein added. Accordingly, claims 1 - 6 and 8 - 24 are presently pending.

I. 35 U.S.C. § 102 Rejections

The Examiner rejects claims 1 – 4, 6 and 9 under 35 U.S.C. § 102 as allegedly anticipated by U.S.P. No. 6,269,184 to Spaulding. The Examiner alleges that Spaulding teaches all of the features of Applicant's independent claims 1, 6 and 9. Contrary to the Examiner's assertions, however, the Spaulding reference is found to be deficient when compared to Applicant's independent claims as explained below.

A. Independent Claims 1 and 6

Independent claims 1 and 6 recite that the image display section displays the color reproduction image together with information as to a distance in the second color space, the distance noting a color difference of, and corresponding to, two points on the color reproduction image designated by the display plot designation system. Spaulding is deficient in view of claims 1 and 6 at least for the following reasons.

Applicant's independent claims 1 and 6 require that the *image display section displays the image reproduction image together with information as to distance in the second color space* (wherein the distance notes a color difference and corresponds to two points on the color reproduction image). The Examiner alleges that somewhere in Spaulding's Column 7, lines 32 – 60, and Figures 5A-C, the previous features are found. Contrary to the Examiner's assertions, however, the previous features are nowhere to be found in the Spaulding reference.

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As a first point, the Examiner compares Spaulding's conventional color printer 24 (*see* Col. 4, lines 44 – 48) to Applicant's recital of a display. Applicant asserts that Spaulding's printer 24 is drastically different from Applicant's display, and only offers the following for the sake of argument.

Assuming that Spaulding's printer 24 somehow amounted to Applicant's recital of a display (which it does NOT), Spaulding continues to be deficient. That is, Applicant's claims 1 and 6 require that the *image display section displays the image reproduction image together with information as to distance in the second color space* (wherein the distance notes a color difference and corresponds to two points on the color reproduction image). As shown in Spaulding's Fig. 3, however, all that Spaulding shows concurrent to the input image 52 is output color spaces 62.

Figs. 5A-C are merely representations of the transformation which occurs when (in step 32 of Spaulding's process) a user "chooses . . . the sun 58 as it appears on the input image 52, finds a patch 60 corresponding to desired printer yellow in the printed ensemble 56, and "clicks on" 34 the corresponding patch 62 on the right-hand side 54 of the monitor 50. *This defines a new constraint specifying that any input color that matches the color of the sun selected in step 32 is to be transformed into the patch color selected in step 34.*" (Col. 6, lines 4 – 11.) In brief, Figures 5A - C merely represent the mentioned transform and are not a part of what is displayed.

An anticipation rejection is only proper where "each and every element as set forth in the claim is found . . . in a single prior art reference." *See* M.P.E.P. § 2131 (*citing Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Because Spaulding's Figures

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5A – C are unequivocally and absolutely NOT displayed together with the image shown in Figure 3, the 35 U.S.C. § 102 rejection of claims 1 and 6 cannot stand, and the Examiner is therefore respectfully requested to reconsider and withdraw this rejection.

B. Independent Claim 9

Claim 9 includes the features of the first color space being device-dependent and the second color space being device-independent. The Spaulding reference fails to teach or suggest that a second color space be a device-independent color space. Contrary to the Examiner's assertion at page 5 of the instant Office Action, Spaulding does not teach that the color transform of input and output data values can be device-independent color spaces, such as a CIELAB color space.

While Spaulding might teach that the *input* color space could be a CIELAB color space, nowhere within Spaulding is there disclosure of a *second* color space being a CIELAB color space. See Spaulding at Column 4, lines 20 – 30. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this deficient anticipation rejection.

To the extent that the Examiner considers any particular features of Applicant's claims to be officially noticed and/or common knowledge (that is, implicit in the Spaulding reference), the Examiner's attention is kindly directed to M.P.E.P. § 2144.03(C), which provides that "[i]f Applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the Examiner **MUST** support the finding with adequate evidence[.]" (Emphasis added.)

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Accordingly, Applicant posits that if the Examiner believes that the above-described features are implicitly disclosed in the Spaulding reference, that such a stance is not properly officially noticed and/or not properly based upon common knowledge. Therefore, if the Examiner believes that the noted features of claim 9 are implicit/common knowledge, the Examiner "*must* provide documentary evidence in the next Office Action if the rejection is to be maintained. If the examiner is relying on personal knowledge to support the finding . . . the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." (Emphasis supplied.) Short of the Examiner withdrawing the rejection, the Examiner is respectfully directed to provide the evidence required by § 2144.03(C).

C. Dependent Claims

As explained above, Applicant's independent claims recite features that are altogether absent in the prior art relied upon as the basis for rejection. Accordingly, Applicant asserts that all of the dependent claims are patentable at least by virtue of being dependence upon one of independent claims 1, 6, or 9.

II. 35 U.S.C. § 103 Rejections

The Examiner rejects claim 5 as allegedly obvious under 35 U.S.C. § 103 in view of Spaulding and U.S.P. No. 6,411,304 to Semba. The Examiner also rejects claim 8 under 35 U.S.C. § 103 in view of Spaulding and U.S.P. No. 5,857,063 to Poe. These rejections are respectfully traversed as explained below.

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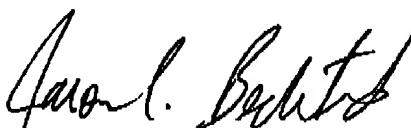
As noted above in Part I of this Amendment, the Spaulding reference is deficient. The patents to Semba and Poe fail to cure Spaulding's deficiencies. Accordingly, claims 5 and 8 are patentable at least by virtue of their dependency upon claim 1.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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23373

CUSTOMER NUMBER

Date: October 25, 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.111 is being facsimile transmitted to the U.S. Patent and Trademark Office this 25th day of October, 2004.


Thea K. Wagner